

**REMARKS**

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 56, 57, 60, 61 and 65-69 are pending in the present application. Claims 57 and 65-69 have been amended without the introduction of any new matter.

In the outstanding Office Action, Claims 66-69 were withdrawn by the Examiner as being directed to a non-elected invention; Claims 56, 57, 60, 61 and 65 were rejected under 35 U.S.C. § 112, second paragraph; and Claims 56, 57, 60, 61 and 65 were rejected under 35 U.S.C. § 103(a) as unpatentable over Tota et al. (U.S. Patent No. 7,308,413, herein “Tota”).

Claims 66-69 were withdrawn by the Examiner as being directed to a non-elected invention. The Examiner’s withdrawal is respectfully traversed.

The 37 CFR 1.145 requires that in order for a restriction to be proper, the new claims must be a distinct invention that is independent of the invention previously claimed. Specifically, 37 CFR 1.145 provides that:

If, after an office action on an application, the applicant presents claims directed to ***an invention distinct from and independent of the invention previously claimed***, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review . . .

37 CFR 1.145 (emphasis added).

The examiner asserts that claims 66-69 are “directed to an invention that is independent or distinct from the invention originally claimed” because “[t]he originally elected independent claim 65 requires no customer having a propriety interest in the innovation as recited from claim 66, nor confidential or non-confidential information as recited from claim 69” (Office Action at p. 2). Applicant disagrees with this assertion and respectfully submits that merely adding additional claims with different limitations which still relate to the same technology does not necessarily make the additional claims distinct from the previously submitted claims. With respect to the present invention, independent Claims 65, 66 and 69 are each computer

implemented system claims for promoting existing inventions. The Examiner has provided no reasons to show why Claims 66-69 are independent and/or distinct other than a general statement noting differences in some of the claim limitations. For instance, the Examiner has not identified a classification, status in the art, or field of search that would be different than the existing claims. See M.P.E.P. §§ 806.06, 808 and 808.02. Applicant respectfully submits that the restriction with respect Claims 66-69 is therefore improper and should be withdrawn. Accordingly, Applicant respectfully requests reconsideration of the Examiner's withdrawal. Applicant provisionally elects Claims 56, 57, 60, 61 and 65 in accordance with 37 C.F.R. § 1.143.

Regarding the rejection of Claims 56, 57, 60, 61 and 65 under 35 U.S.C. § 112, the claims are modified in light of the comments noted in the outstanding Office Action. The consumer desirability has also been clarified below. Accordingly, it is respectfully requested this rejection be withdrawn.

Claims 56, 57, 60, 61 and 65 were rejected under 35 U.S.C. § 103(a) as unpatentable over Tota. That rejection is respectfully traversed.

Applicant's invention is a computer implemented, on-line, system that aides inventors and other intellectual property owners promote and market their respective existing inventions. It accomplishes such objective through the use of a computerized communication network in which satellite computer stations (e.g., personal computers) operatively and interactively connected over the network with the host computer (e.g., Internet domain site), provide three principal distinct functions: (1) provides a data base in which the inventors or other intellectual property owners can store descriptions of their respective inventions as well as the distinctive features typifying such inventions, (2) elicits and stores consumer feedback as to the commercial attractiveness or desirability of the inventions, and (3) provides industry (as well as inventor) access to the stored consumer opinions about the respective inventions. The computerized system of this invention therefore not only provides the inventors and other intellectual property owners means for displaying on line pertinent data about their respective inventions, but enables valuable consumer input about such inventions, accessible by the inventor (or other intellectual property owners) as well as the industry representatives, to assist in evaluating the potential

market for, or needed changes to, an invention, in order to maximize the market for such invention.

Amended independent Claim 65 is directed to a computer implemented system promoting existing inventions over the Internet communications network. The system includes (I) a host computer station constituting an Internet domain site connected to the network and having a data base with stored descriptions of respective inventions and their distinctive features, (II) plural consumer computer stations operatively and interactively connected over the network with the host computer, (III) a computer program module selecting at least one of the inventions by reference to the stored invention descriptions and distinctive features for viewing at the plural consumer computer stations and thereafter providing feedback data relating to a consumer desirability of the selected inventions. The computer program module includes a survey module eliciting the feedback data from multiple users of the consumer computer stations by posing one or more questions to the users regarding the consumer desirability and consolidating their responses. The system further includes (IV) a computer program module forwarding the consolidated responses to the host computer station to provide an information summary of the consumer desirability for the respective selected inventions, (V) plural industry computer stations operatively and interactively connected over the network with the host computer and specifically identified by the host computer as authorized to access the information summary, and (VI) a computer program module transferring the information summary to the authorized industry computer stations.

Similarly, amended independent Claim 66 is directed to a computer implemented system for obtaining informed consumer opinions over a communications network regarding the commercial attractiveness of existing customer inventions. The system includes (I) a host computer station connected to the network and having a data base storing identification of customers and descriptions of respective inventions of the customers, including distinctive features of the inventions, (II) plural customer computer stations operatively and interactively connected over the network with the host computer station, (III) plural consumer computer stations operatively and interactively connected over the network with the host computer station, (IV) a first computer program module enabling each of the customers to transmit their respective customer identifications and descriptions of their inventions, including the distinctive features of

the inventions, to the data base, (V) a second computer program module (i) enabling access by the consumers at the plural consumer computer stations to the inventions by reference to the stored invention description, (ii) thereafter providing feedback data relating to the commercial attractiveness of the selected inventions, the second computer program module including a survey module eliciting the feedback data from multiple ones of the consumer computer stations by posing one or more questions and responding to the answers thereto constituting such feedback data, and (iii) thereafter consolidating the answers to provide respective information summaries regarding the commercial attractiveness of the selected inventions, and (VI) a third computer program module forwarding the information summaries to the host computer station for storage in a data base. The users of the customer computer stations are customers who own respective proprietary interests in the inventions. The users of the consumer computer stations are consumers who constitute potential purchasers of products incorporating the inventions.

Amended independent Claim 69 is directed to a computer implemented system promoting existing inventions over the Internet communications network. The system includes (I) a host computer station connected to the network and having a data base with stored invention information, including confidential invention information and non-confidential invention information, (II) at least one industry computer station operatively connected over the network with the host computer, (III) a computer program enrollment module enrolling an industry representative user of the industry computer station as an industry representative wishing to access the confidential invention information, and (IV) a computer program invention disclosure module selectively granting the industry representative user access to the confidential invention information upon execution by the industry representative user of the confidentiality agreement. The enrollment module conditions access upon the industry representative executing a confidentiality agreement regarding the confidential invention information.

In a non-limiting example, Figures 1, 5 and 5A illustrate a system for promoting existing inventions. The promoting of inventions may include advertising intellectual property available for license or sale and obtaining feedback (see, e.g., page 1, lines 2-4). The present invention recognizes that it is desirous to provide relevant information regarding inventions (including without limitation feedback information and distinctive features of the invention) to consumers and to industry representatives in order to increase the consumer's and/or industry's

understanding and appreciation of the intellectual property and any related product (see also page 14, lines 2-6). Such information may include survey information (see also page 14, line 9 to page 14, line 16). As shown in Figure 1, the system of the present invention includes a host station 12 in communication with customer stations 14, industry stations 16 and consumer stations 18 (see also page 7, lines 10-13). According to one embodiment, host station 12 is an Internet domain site and customer stations 13, industry stations 16 and consumer stations 18 are each personal computers in communication with the host station over the Internet (see also page 7, line 14-16). A consumer station 13 includes a customer that holds intellectual property and that desires to enter into an arrangement with a third party, such as a license agreement, assignment, sale, joint venture, obtain loans, obtain feedback, etc. (see also page 8, line 16 to page 9, line 2). An industry station 16 includes an industry representative that desires to enter into an arrangement with a third party, such as a license agreement, assignment, sale, joint venture, obtain loans, obtain feedback, etc., for the purpose of financing, making, selling and/or distributing intellectual property (see also page 9, lines 3-10). A consumer station includes a consumer representative that may potentially purchase a product or products based on the intellectual property (see also page 9, lines 11-13). The system 10 includes a survey module 40 which, according to one embodiment, provides questions to a user and receives the user's input. The questions may ask for information relating to the intellectual property or product, such as overall rating, likes, dislikes, price or price range, likelihood of purchasing the product. Survey results are tabulated for each intellectual property item and displayed, along with any consumer comments (see also page 14, line 9 to page 14, line 16). The pertinent industry may ascertain from the tabulated results whether the intellectual property or product would meet the industry's goals. Likewise, the customer may benefit from survey results by determining whether more energy should be devoted to product development and/or intellectual property protection (see also page 14, line 9 to page 14, line 16).

The present invention relates to advertising inventions available for license or sale and obtaining feedback or, said in another non-limiting way, promoting inventions (see, e.g., page 1, lines 2-4, claim 65). The present invention thus does not relate to *creating* media content, but, instead relates to promoting existing inventions (*i.e.*, the consumer desirability indicates how well consumers desire the existing intellectual property and it is not used to create new intellectual property). Unlike the present invention, Tota does not relate to a computer

implemented system that promotes existing inventions over an Internet communications network. Instead, Tota relates to “to the creation and distribution of media content such as television programming, movies, music and the like” (Tota at col. 1, lines 14-16), and discloses “a process for ***creating media content based upon submissions*** received on an electronic multi-media exchange” (Tota at col. 3, lines 12-14) (emphasis added). Although Tota briefly references content material that ***might*** be protectable or non-protectable through a copyright, trademark or patent (Tota col. 3, lines 24-33), it discusses such in the context of protecting such rights and in creating additional media content (Tota col. 2, line 63 to col. 3, line 1) rather than in promoting existing inventions.

According to the claimed present invention, the computer system includes a host computer station having a data base with stored descriptions of respective inventions and their ***distinctive features***, and a computer program module selecting a selecting inventions by reference to the stored invention descriptions and distinctive features for viewing. Applicant submits that the distinctive features is information regarding the invention itself and is useful in locating such inventions. Although Tota discloses that “content material may be filtered . . . based on key words in the title and/or text as well as categorical information supplied by the submitter” (Tota at col. 24, lines 52-62), it does not disclose that an invention may be selected based on distinctive features of the invention.

Tota does not teach or suggest providing an information summary of consumer desirability for respective selected inventions. In fact, Tota is entirely silent with regards to summarized information. Applicant respectfully disagrees with the Examiner that such summarized information is well known in the art. Tota also does not teach or suggest a survey module eliciting the feedback data from multiple users that consolidates consumer responses with respect to consumer desirability. Tota further does not teach or suggest transferring the information summary to industry computer stations.

As stated in M.P.E.P. § 2143, a basic requirement for a *prima facie* case of obviousness is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. As the cited references do not teach or suggest the features of (i) a computer implemented system promoting existing inventions over the Internet communications network,

(ii) a computer program module selecting a selecting inventions by reference to the stored invention descriptions and distinctive features, (iii) an information summary of consumer desirability for respective selected inventions, (iv) a survey module eliciting the feedback data from multiple users that consolidates consumer responses with respect to consumer desirability, or (v) transferring the information summary to industry computer stations, it is respectfully submitted the outstanding Office Action has not created a *prima facie* case of obviousness with regard to independent Claim 65, and the claims dependent therefrom.

Additionally, dependent Claims 57, 60 and 61 are further distinguished from the cited art. Although Tota discloses that the content is given a “unique tracking number,” it does not disclose use of a Standard Industrial Classification code or a North American Industry Classification System code as required by dependent Claim 57. Tota also does not disclose a confidential information description of inventions as required by dependent Claims 60 and 61.

Accordingly, it is respectfully requested this rejection be withdrawn.

Applicant submits that similar reasoning as above applies to independent Claims 66 and 69, and the claims dependent therefrom, with respect to Tota.

**CONCLUSION**

In light of the arguments set forth above, Applicant respectfully submits that the Application is now in allowable form. Accordingly, Applicant respectfully requests consideration and allowance of the currently pending claims.

The Commissioner is hereby authorized to charge the fee for a one month extension in the amount of \$65 along with the fee for a Request for Continued Examination in the amount of \$405. It is believed that no additional fees are due at this time. If this is incorrect, Applicant hereby authorizes the Commissioner to charge any fees, other than issue fees, that may be required by this paper to Deposit Account No. 07-0153. The Examiner is respectfully requested to call Applicant's Attorney for any reason that would advance the current application to issue. Please reference Attorney Docket No. 125446-1001.

Dated: March 30, 2009

Respectfully submitted,  
GARDERE WYNNE SEWELL LLP

  
\_\_\_\_\_  
Karl L. Larson  
Registration No. 41,141  
ATTORNEY FOR APPLICANT

3000 Thanksgiving Tower  
1601 Elm Street  
Dallas, Texas 75201-4761  
(214) 999-4582 - Telephone  
(214) 999-3623 - Facsimile